



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/214,155 12/29/98 TAKAYAMA

H 052816

EXAMINER

HM12/0612

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037-3202

0471.5	
ART UNIT	PAPER NUMBER

1616

DATE MAILED:

06/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/214,155

Applicant(s)

Hiroaki Takayama et al.

Examiner

Sabiha N. Qazi

Art Unit

1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 4, 2001
- 2a) ☒ This action is **FINAL**.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

18) ☐ Interview Summary (PTO-413) Paper No(s) _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Application/Control Number: 09/214,155

Art Unit: 1616

Final Action on Merits

Status of the Application

Claims 3 and 4 are pending and are rejected.

No claim is allowed.

Claims 1 and 2 are canceled.

Applicant's response and request for re-consideration, filed in paper no. 22, dated 4/4/01 is hereby acknowledged. Applicant's arguments were fully considered but are not found persuasive. Claims 3 and 4 are entered however, amendment in specification by inserting a the synthetic scheme on page 32 is not entered. It constitutes new matter. Since the criticality of the invention is the difference in configuration the amendment in specification will not be entered. The compound of example is 20S but the scheme was not in the original specification.

1. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (US Patent 5,877,168) and claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Trost M. Barry et al. (J. Am. Chem. Soc., Vol. 114, No. 25, (1992), pages 9836-45) is maintained.

The arguments and reasoning is confusing it is not clear what has been accomplished by the provided results. See MPEP

Art Unit: 1616

716.02(e). The concentration of each compound compared is not the same.

1. Claims 3 and 4 provisionally stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 and 4 of copending Application No. 09/068219. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Applicant's copending application 09/214,155 contains the same invention as claimed in this instant application 09/068,219. In the instant applications applicants are claiming 20-S compounds whereas in 09/068,219 the compound with 20-R are claimed. These compounds are considered obvious over the other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of


Art Unit: 1616

the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

6/10/01


SABIHA QAZI, PH.D
PRIMARY EXAMINER